

REMARKS/DISCUSSION:

This Amendment D is being filed within three months after the shortened statutory period for response that ended on May 11, 2004. Accordingly, a Petition for a Three-Month Extension of Time is attached hereto.

By this Amendment D, claims 21-34 remain pending in this application.

Applicant has carefully studied the outstanding Office Action. This Amendment is intended to be fully responsive to all points of rejection raised by the Examiner and is believed to place the application in condition for allowance. Favorable reconsideration and allowance of the application are respectfully requested.

Rejection under 35 U.S.C. § 102(b)

Claims 21-27 and 30-34 stand rejected as being anticipated by Idemoto (E 0 456 470) as stated on pages 2 and 3 of the Office Action.

Independent Claims 21 and 30 have been amended to recite a:

a balance region proximal to the treatment segment;

Applicant respectfully submits that Idemoto neither discloses nor suggests a balanced region proximal to the treatment segment (region) or in the very least a balanced ultrasonic curved end effector.

Applicant is puzzled how the Examiner can state on page 2 of the Office Action the following:

"Located on both side walls is a balance asymmetry. Because the balance asymmetries have more material toward the edges of the device and less in the middle, the asymmetries will counter torque."

Applicant respectfully transverses the Examiner's interpretation of what Idemoto teaches and the rejection of Independent Claim 23 and its associated dependent claims and Claims 21 and 30, as now amended, and their associated dependent claims based on the Examiner's interpretation of Idemoto.

According to Applicant's understanding, the Idemoto reference neither teaches nor suggests the elements of the Applicant's invention as now claimed. It is Applicant's understanding that a claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference. See for example MPEP 2131.

The Idemoto reference does not teach or suggest at least one balance asymmetry or a balance asymmetry positioned to counter torque created by the curved treatment portion. Nor has the Examiner identified any portion of the Idemoto reference that teaches Applicant's claimed structure or even discloses an appreciation that torque is created by the curved treatment portion identified by the Examiner. In pages 2 and 3 of the Office Action the Examiner has simply *assumed* that certain portions of the blade illustrated in Fig. 6B in Idemoto are balance portions, without any suggestion from Idemoto that balance portions are needed or even exist in the disclosed blade design. Therefore, according to the Examiner, the alleged balance portions shown on page 3 of the Office Action counter torque created by the curved treatment section of Idemoto without any suggestion by Idemoto that torque created by the curved treatment section even exists in the disclosed blade or is a problem that needs to be addressed. Further, nothing in the text of the Idemoto reference supports the Examiner's contention that the alleged balance portions identified in the Office Action act as a balance portion or that there are any elements illustrated or described in Idemoto that counter torque created by the curved treatment portion. The Examiner has simply assumed that the Idemoto blade is balanced without any support from the Idemoto specification.

This is especially perplexing considering that Idemoto never mentions balance asymmetries or that the need to counter torque is even a problem. Idemoto provides 5 sentences within 2 paragraphs to discuss the curved end effectors illustrated in Figs. 5, 6A-B. The discussion is limited to a curved embodiment suitable for a cutting operation when the visual field is restricted or a screw-mounted attachment means. Col. 4, lines 1-10. There is not even a hint that the shape of the Idemoto blade contributes to a balance function.

Further, Applicant respectfully traverses the Examiner's rejection of the claims because the rejection is based on impermissible hindsight and not upon the actual teaching of the Idemoto reference. Specifically, the Examiner has taken Applicant's problem and teaching to overcome the problem and proposing, without support in the Idemoto reference, that Fig. 6A of Idemoto incorporates Applicant's claimed invention to solve a problem that Idemoto does not even recognize. The Examiner's assumption that the blade in Idemoto generates undesirable torque and the Examiner's contention that the blade in Idemoto is balanced appear to be based solely on the combination of Applicant's teaching and hindsight. Accordingly, Applicant respectfully requests reconsideration of this rejection.

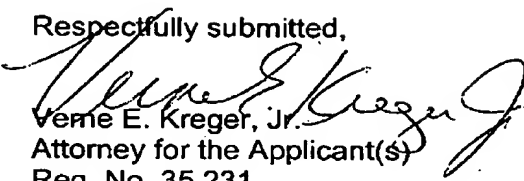
Conclusion

Applicant submits that in view of the claim amendments and discussion, the rejections under 35 U.S.C. § 102(b) have been overcome and that the invention is now patentable over the cited prior. The Examiner is respectfully requested to reconsider all rejections and pass this case to issue.

Should any minor points remain prior to issuance of a Notice of Allowance, the Examiner is requested to telephone the undersigned at the below-listed telephone number.

The Commissioner is hereby authorized to charge any additional fees, which may be required to Account No. 10-0750/END-778/VEK.

Respectfully submitted,


Verne E. Kreger, Jr.
Attorney for the Applicant(s)
Reg. No. 35,231

Johnson & Johnson
One Johnson & Johnson Plaza
New Brunswick, NJ 08933-7003
513 337-3295
DATED: August 5, 2004